

### **REMARKS/ARGUMENTS**

This Reply is being filed in response to the final Official Action issued following a decision on a Pre-Appeal Brief Request for Review to re-open prosecution. The Official Action now rejects all of the pending claims, namely Claims 1-54, under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0024879 to Dingman et al. (referred to in the Official Action and herein as “D1”), in view of U.S. Patent Application Publication No. 2004/0005886 to Oda et al. (referred to in the Official Action and herein as “D2”). As explained below, Applicant respectfully submits that the claimed invention is patentably distinct from D1 and D2, taken individually or in any proper combination. In view of the remarks presented herein, Applicant respectfully requests reconsideration and allowance of all of the pending claims of the present application. Alternatively, as the remarks presented herein do not raise any new issues or introduce any new matter, Applicant respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal.

#### ***A. Claim Construction and Prima Facie Anticipation/Obviousness***

Initially, Applicants note that the Patent Office has the initial burden of proof in establishing *prima facie* anticipation or obviousness of a claimed invention under 35 U.S.C. § 102 or § 103. *In re Warner*, 379 F.3d 1011, 1016 (CCPA 1967). To make a fair review of the merits of a *prima facie* case of anticipation or obviousness, “[t]he Examiner must make specific findings as to claim construction.” *Ex parte Beery*, Appeal No. 2008-0543, Application No. 09/954,823 (BPAI Sep. 29, 2008) (emphasis added); *Ex parte Blankenstein et al.*, Appeal No. 2007-2872, Application No. 10/116,312 (BPAI Aug. 26, 2008); and *see Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997); and MPEP §§ 706, 706.07.

In the final Official Action, the Office has failed to provide Applicants with a sufficient claim construction and corresponding interpretation of the cited references so as to enable the Applicants to make a fair review of the merits of the case of anticipation or obviousness proffered by the Examiner, or to effectively reply or readily judge the advisability of an appeal. In fact, the analysis provided in the Official Action does not even pertain to the currently-pending claims. Instead, the analysis provided in the Official Action provides to different claims from a corresponding Chinese patent application. The Official Action does suggest that the

scope of the currently-pending claims and those from the corresponding Chinese patent application have the same scope, but nowhere does the Official Action provide a basis for this suggestion.

Applicants therefore respectfully submit that the Examiner has failed to establish *prima facie* anticipation or obviousness of the claimed invention. Should the Examiner continue to reject the claims as being unpatentable over the same or any other ground, Applicants respectfully request that the Examiner submit on the record specific findings as to the construction being applied to the currently-pending claims and not those of another, foreign patent application. Applicants further respectfully request that the Examiner submit on the record an explanation of the references being cited against the currently-pending claims, and how those references disclose recited features of the currently-pending claims.

***Claims 1-54 are Patentable*** Notwithstanding the failure of the Official Action to substantively treat the currently-pending claims, Applicants respectfully submit that Claims 1-54 are patentably distinct from D1 and D2, taken individually or in any proper combination.

**1. *Claims 1-9, 19-27 and 37-45 are Patentable over D2***

Relative to independent Claim 1 (and similarly independent Claims 19 and 37), Applicants presume the Official Action alleges the following correspondence between independent Claim 1 and D2, citing FIGS. 9, 10 and 12, and paragraphs [0112]-[0130] and [0145]-[0153] of D2.

<b>Claim 1</b>	<b>D2</b>
An apparatus comprising: a processor; and a memory including computer program code, the memory and computer program code configured to, with the processor, cause the apparatus to at least perform the following:	Control Proxy Server (CPS) 131a
receiving a connection request via a network across which an originating client is configured to communicate;	the CPS 131a ... receives an IP packet containing a call setting message via an IP network [101a] and extracts the MSISDN on the called side;

preparing a network-independent trigger for transmission to a terminal in response to receiving the connection request; and	the CPS sends the call setting message to the radio terminal b [110b] via MSC [121] and BS [122b] (corresponding to a mobile communication network different from the IP network);
receiving a registration message, in response to the trigger, from the terminal via the network to thereby register the terminal with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity of the terminal.	[the CPS] receives the response message returned from the radio terminal b [110b] via the base station [122b] and the MSC [121], the response message containing the IP address and port number of the IP network [for radio terminal b], such that the CPS is capable of identifying the radio terminal b via the identification of the IP network (i.e., the IP address and port number) and establishing a session with the radio terminal b.

Notwithstanding the cited figures and passages of D2 encompassing FIG. 10, Applicants note that relative to the system shown in FIG. 9, the only embodiment in which the CPS sends a call setting message to radio terminal b via a base station (BS) and MSC is shown and described with respect to FIGS. 11 or 12 – provided the GW 130 is considered a BS in the embodiment of FIG. 11. The embodiment of FIG. 10 does not employ the MSC, and instead passes all communication outside the cellular network that includes the MSC.

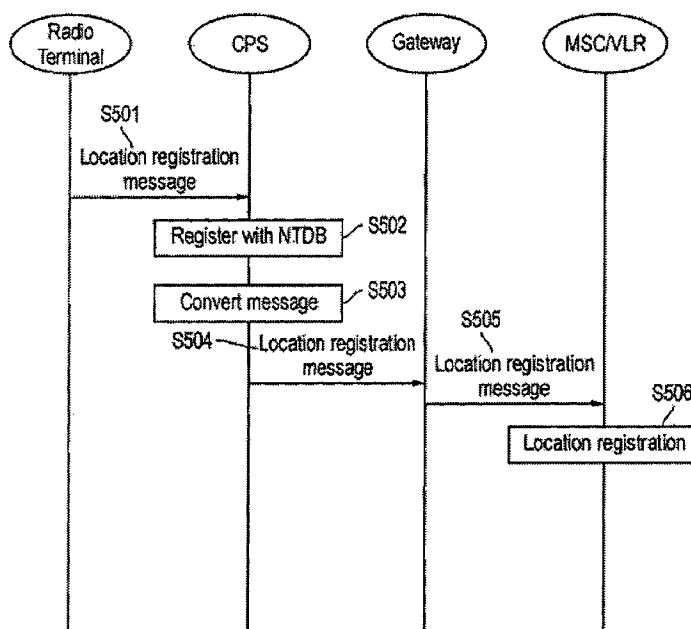
**(a) Network-Independent Trigger**

Applicants note that in the embodiments of FIGS. 11 and 12, the CPS 131a (alleged apparatus) sends the call setting message to MSC 121a through GW 130a. The CPS 131a and GW 130a are both in local IP network 101a via which the CPS receives the call setting message from radio terminal a 110a. As per D2, the CPS 131a receives a call setting message via local IP network 101a, and sends the call setting message to radio terminal b 110b via the local IP network 101a (including GW 130a) – and also via cellular network 100. As may be readily seen, then, the call setting message from the CPS 131a is not “network-independent,” similar to the trigger of independent Claim 1 (and similarly independent Claims 19 and 37). That is, the call setting message from CPS 131a of D2 is not independent of the local IP network 101a via which the CPS 131a received the call setting message from radio terminal 110a.

**(b) Registration Message**

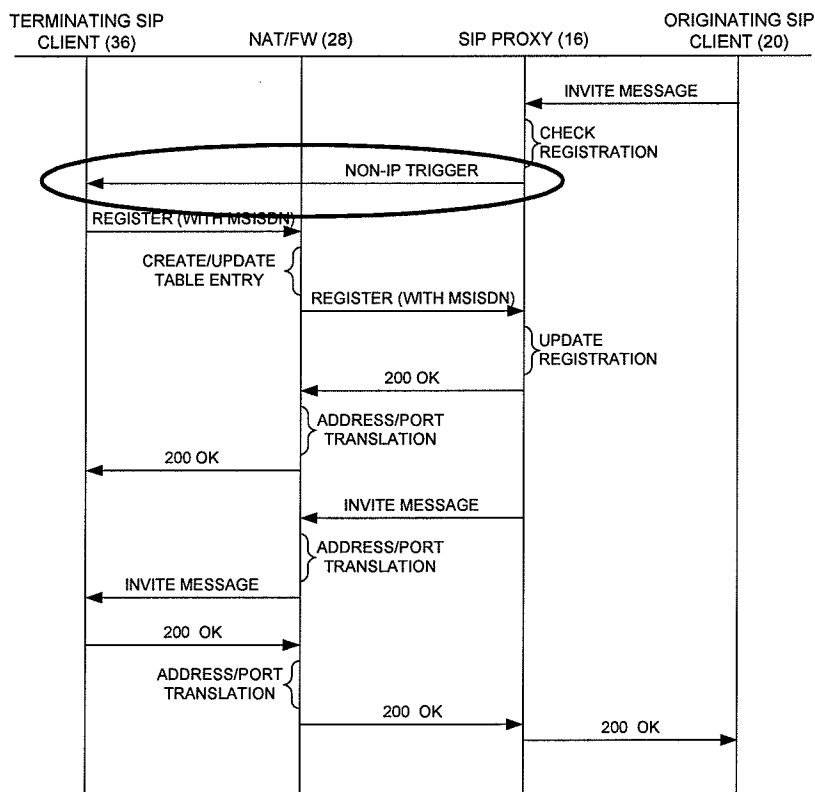
The Official Action asserts that the CPS 131a (alleged apparatus) of D2 does not receive a registration message, but that instead another node of the system – such as the NTDB – receives the registration message. Nonetheless, the Official Action asserts that it would have been obvious to have modified D2 so that the CPS receives the registration message. Applicants note, however, that the CPS of D2 includes the NTDB; and thus, to the extent that the NTDB receives a registration message, the CPS receives the registration message. This is clearly shown in FIG. 5 of D2, reproduced below.

Briefly and with reference to its FIG. 5, D2 discloses a system and method for registering the location of a radio terminal in a cellular network, where the registration is effectuated across an IP network. As disclosed, a radio terminal formulates an IP packet including a location registration message for a cellular network, and sends the message to a CPS (radio terminal controlling apparatus) via an IP network. The CPS stores a correspondence between identification information on a radio terminal and an IP address based on a location registration request. If necessary, a GW (location registration auxiliary apparatus) converts the location registration request into the location registration message in compliance with a standard of the cellular network. The location registration message is transferred to an MSC/VLR in the cellular network via the GW, where the MSC/VLR registers the location of the radio terminal in the cellular network in response to the location registration message.



D2, FIG. 5

In contrast to independent Claim 1 (and similarly independent Claims 19 and 37), D2 does not teach or suggest an apparatus receiving a registration message in response to a network-independent trigger to thereby register with the apparatus and acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session with the terminal based upon the network-dependent identity. This distinction is clearly illustrated by comparison of FIG. 5 of D2 and FIG. 5 of the present application (reproduced below), where for example, D2 clearly does not include a network-independent trigger (e.g., NON-IP TRIGGER) – circled in the annotated FIG. 5 of the present application – to trigger the terminal to register and acquire a network-dependent identity of the terminal. And further, nowhere does D2 teach or suggest receiving, in response to a network-independent trigger, a registration message via the network, to register the terminal and acquire a network-dependent identity of the terminal, similar to independent Claim 1.



Pat Appl., FIG. 5 (flipped)

Applicants again note that the Official Action equates the call setting message from the CPS of D2 as corresponding to the network-independent trigger of independent Claim 1. But even if one accepted this proposition (albeit incorrectly), neither the CPS nor any other node of the system (e.g., NTDB) receives a registration message in response to the call setting message from the CPS, similar to the claimed apparatus receiving a registration message in response to the network-independent trigger.

## 2. *Claims 10-18, 28-36 and 46-54 are Patentable over D2*

Applicants first note that the Official Action treats independent Claim 10 in a manner similar to that of independent Claim 1, even though the claims including different (albeit similar) features. Applicants also note that although the Official Action rejects independent Claim 10 as being unpatentable over D1, in view of D2, the Official Action on page 8 alleges that

independent Claim 10 lacks “novelty” with respect to D2 – thereby presumptively rejecting Claim 10 as being anticipated by D2. These inconsistencies (along with the reasons provided above in section A) further demonstrate that the Official Action has failed to provide Applicants with a sufficient claim construction and corresponding interpretation of the cited references so as to enable the Applicants to make a fair review of the merits of the case of anticipation or obviousness proffered by the Examiner, or to effectively reply or readily judge the advisability of an appeal. And accordingly, further demonstrate that the Examiner has failed to establish *prima facie* anticipation or obviousness of the claimed invention.

In contrast to independent Claim 10 (and similarly independent Claims 28 and 46), D2 does not teach or suggest an apparatus receiving a registration message from a terminal via a network, the registration message including a network-independent identity of the terminal so that the terminal may be sent a network-independent trigger in a manner similar to that recited by independent Claim 1. More particularly, D2 does not teach or suggest an apparatus being caused to receive via a network, a registration message including a network-independent identifier of a terminal. Further, D2 does not teach or suggest being caused to prepare a network-independent trigger for transmission to the terminal based on the network-independent identifier to thereby acquire a network-dependent identity of the terminal to thereby enable establishment of a communication session based upon the network-dependent identity of the terminal. Again, with reference to FIG. 5 of D2 above, D2 clearly does not include a network-independent trigger (e.g., NON-IP TRIGGER) to trigger the terminal to update registration of the terminal, including acquisition of a network-dependent identity of the terminal.

Applicant therefore respectfully submits that independent Claim 1, and by dependency Claims 2-9, is patentably distinct from D2. Applicant also respectfully submits that independent Claims 10, 19, 28, 37 and 46 recite subject matter similar to that of independent Claim 1, including the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established. As such, Applicant also respectfully submits that independent Claims 10, 19, 28, 37 and 46, and by dependency Claims 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from D2 for at least the same reasons given above with respect to independent Claim 1.

Applicants further respectfully submits that D1 does not cure the deficiencies of D2. That is, even considering D1, neither D2 nor D1, taken individually or in any proper combination, teaches or suggests the aforementioned triggering the terminal (or an apparatus) or identifying the terminal (or an apparatus) independent of the network for which a communication session may ultimately be established, as per amended independent Claims 1 and 8. Nor is there any apparent reason for modification of D2, D1 or any alleged combination of D2 and D1 to teach the claimed invention. Applicants therefore respectfully submit that independent Claims 1, 10, 19, 28, 37 and 46, and by dependency Claims 2-9, 11-18, 20-27, 29-36, 38-45 and 47-54, are patentably distinct from D2 and D1, taken individually or in any proper combination.

For at least the foregoing reasons, Applicants submit that the rejection of Claims 1-54 as being unpatentable over D1, in view of D2 is overcome.



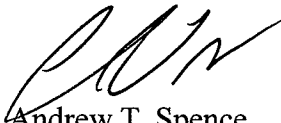
Application No.: 10/797,765  
Amendment Dated September 22, 2010  
Reply to Official Action of August 16, 2010

### **CONCLUSION**

In view of the remarks presented above, Applicant respectfully submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues. As explained above, no new matter or issues are raised by this Reply, and as such, Applicant alternatively respectfully requests entry of this Reply for purposes of narrowing the issues upon appeal.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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